

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 24, 2004. Claims 1-40 were pending in the application. Applicants have amended various claims and have cancelled Claims 9, 23, and 31. Applicants submit that no new matter has been added with these amendments. Applicants submit that the pending claims are patentably distinguishable over the cited references. Applicants, therefore, respectfully request reconsideration and favorable action in this case.

Section 102 Rejections

The Office Action rejects Claims 30-33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,684,800 issued to Dobbins, et al. ("Dobbins"). Applicants respectfully traverse this rejection and all assertions therein for the reasons given below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (*emphasis added*). In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis original*)). Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. M.P.E.P. § 2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. and Inter. 1990) (*emphasis original*)).

Independent Claim 30 recites, "a first port and a second port each including a receive-transmit pair (RTP), the RTP including a high-speed demultiplexer operable to process ingress traffic, a high-speed multiplexer operable to process egress traffic, and an

2003/0165140 to Tang, et al. ("Tang"). The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Dobbins* in view of *Tang* as applied to Claim 10, and further in view of U.S. Patent 6,148,000 issued to Feldman, et al. ("Feldman"). Applicants respectfully traverse this rejection and all findings therein for the reasons given below.

Independent Claim 1 recites, "an identifier operable to represent the port group as a single element to disparate elements and associated with a single network address." For the teaching of this limitation, the Office Action offers the MVLAN-ID disclosed in *Tang*. However, Applicants submit that the Office Action fails to consider each and every word of Claim 1. "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). In judging the patentability of Claim 1, the Office Action fails to consider at least the phrase "an identifier ... associated with a single network address." In contrast to this limitation recited in Claim 1, the MVLAN identifier disclosed in *Tang* is associated with multiple network addresses. Each end station (e.g., 20A-C of Figure 5) has a unique network address such as a MAC address. Col. 2, Lines 62-63. Each VLAN identifier is associated with a subset of these end stations as illustrated in Figure 5. Col. 2, Lines 64-66. For example, VLAN 100, as illustrated in Figure 5, is associated with end stations 20A, 20B, 20D, 20F, 20H, and 20I, and each of these end stations has a different network address. Thus, the offered identifier is associated with a plurality of network addresses, not "a single network address" as claimed.

Furthermore, Claim 1 has been amended to include all the limitations of canceled Claim 9. Therefore, amended Claim 1 also recites, "wherein the transport element is defined in a transport network including a plurality of transport elements, further comprising the transport element unaware of topologies of the other transport elements in the transport network." The Office Action fails to cite any passage of *Dobbins* or *Tang* that discloses this limitation. Furthermore, Applicants submit that neither *Dobbins* nor *Tang* discloses this limitation. Accordingly, Applicants respectfully request reconsideration and allowance of independent Claim 1, as well as Claims 2-15, which depend from Claim 1.

Independent Claims 16 and 34 recite limitations that are similar, although not identical, to the limitations of Claim 1 discussed above. Therefore, these claims are allowable for reasons analogous to those discussed above in connection with Claim 1. Furthermore, Claims 17-29 and 35-40 depend from independent Claims 16 and 34, respectively, and are thus also patentable over the cited art. Favorable action is therefore respectfully requested.

Moreover, Claim 14, which depends from Claim 1, recites, “each port operable to receive Internet protocol (IP) packets, to add an internal transport overhead to the IP packet to generate an internal packet, and to transmit the internal packet directly on an optical link to an egress port in the port group.” Claim 28 recites a similar, although not identical, limitation. The Office Action fails to cite any passage for the teaching of this specific limitation and instead generally offers SFPS switches acting as IP routers for the teaching of Claim 14. However, this does not provide a teaching of the recited limitation, and specifically does not disclose, teach, or suggest “add[ing] an internal transport overhead to the IP packet to generate an internal packet.” Accordingly, for at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 14 and 28.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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